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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/057,937	01/29/2002	Yutaka Iyoki	P21953	3791

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EXAMINER

SERRAO, RANODHI N

ART UNIT	PAPER NUMBER
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2141

NOTIFICATION DATE	DELIVERY MODE
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08/23/2007

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

gbpatent@gbpatent.com
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Office Action Summary

Application No.

10/057,937

Applicant(s)

IYOKI, YUTAKA

Examiner

Ranodhi Serrao

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 July 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 15-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 15-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 16 July 2007 have been fully considered but they are not persuasive. The applicant argued in substance the newly added limitations of independent claims 15, 20, and 21. However, the cited prior art of record continue to teach these and the added features.

2. The applicant argued,

However, SHAFFER et al. fails to disclose at least a terminal apparatus that starts the application program associated with the obtained file type to open the received document file based upon the application program determined in the search without user input, when it is determined that the application program associated with the obtained file type is stored in the memory.

3. The examiner respectfully disagrees. The claim recites, **start the application program** associated with the obtained file type to open the received document file based upon the application program determined in the search **without user input**. Emphasis added. Correctly interpreting the claim language shows that an application program is started without user input. The claim does not recite opening the received document file without user input. The application program that is started without user input is associated with the obtained file type to open the received document file. In this sense, Shaffer teaches starting an application program without user input that is associated with an obtained file type to open the received document file. See col. 1, line 55-col. 2, line 4, wherein Shaffer states, "Alternatively, the **application program may be loaded** as soon as the e-mail message itself is opened, **without waiting for**

the user to click on the attachment icon.” Emphasis added. Therefore Shaffer teaches the claimed limitations.

4. The applicant furthermore argued,

Moreover, the Examiner has not set forth a proper reason for combining SHAFER et al. with SHIH.

5. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, in the reference. The examiner has pointed out explicitly in the rejection where the motivation lies. See below. Furthermore, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). Both Shaffer and Shih teach files attached to email that are sent via a network and processed. The applicant's invention is also directed towards sending files via a network and processing the files. Therefore the combination is proper under 35 U.S.C. 103.

6. The examiner points out that the pending claims must be “given the broadest reasonable interpretation consistent with the specification” [In re Prater, 162 USPQ 541

(CCPA 1969)] and “consistent with the interpretation that those skilled in the art would reach” [In re Cortright, 49 USPQ2d 1464 (Fed. Cir. 1999)]. In conclusion, upon taking the broadest reasonable interpretation of the claims, the cited references teach all of the claimed limitations. And the rejections are maintained. See below.

Claim Rejections - 35 USC § 103

7. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
8. Claims 15, 20, 23, 25, and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shaffer et al. (6,785,867) and Shih (6,504,626)
9. As per claim 15, Shaffer et al. teaches a memory configured to store information indicating a plurality of file types and an application program associated with each of the plurality of the file types, each application program being configured to open a document file associated with at least one of the plurality of the file types; (see Shaffer et al., col. 4, lines 9-56); analyze the file name included in the received control file to obtain the file type of the received document file; determine whether the application program associated with the obtained file type is stored in the memory; search the memory to determine the application program associated with the obtained file type from the application programs stored in the memory (see Shaffer et al., col. 5, lines 34-64); and start the application program associated with the obtained file type to open the received document file based upon the application program determined in the search without user input, when it is determined that the application program associated with

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the obtained file type is stored in the memory (see Shaffer et al., col. 5, line 65-col. 6, line 33). But fails to teach a terminal apparatus configured to receive image data from a scanner, the terminal apparatus comprising: an interface configured to be connected to the scanner via a network; and a controller configured to: receive, from the scanner, a control file including a file name; receive, from the scanner, a document file, the document file including image data scanned by the scanner. However, Shih teaches a terminal apparatus configured to receive image data from a scanner, the terminal apparatus comprising: an interface configured to be connected to the scanner via a network; and a controller configured to: receive, from the scanner, a control file including a file name; receive, from the scanner, a document file, the document file including image data scanned by the scanner (see Shih, col. 3, lines 10-26). It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Shaffer et al. to a terminal apparatus configured to receive image data from a scanner, the terminal apparatus comprising: an interface configured to be connected to the scanner via a network; and a controller configured to: receive, from the scanner, a control file including a file name; receive, from the scanner, a document file, the document file including image data scanned by the scanner in order to allow a large number of functions of the scanner, such as e-mailing, to be easily inputted through the keys on a keyboard (see Shih, col. 3, lines 33-46).

10. As per claim 20, Shaffer et al. teaches to store, in a memory, information indicating a plurality of file types and an application program associated with each of the plurality of the file types, each application program being configured to open a

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document file associated with at least one of the plurality of the file types (see Shaffer et al., col. 4, lines 9-56), analyze the file name included in the received control file to obtain the file type of the received document file; determine whether the application program associated with the obtained file type is stored in the memory; search the memory to determine the application program associated with the obtained file type from the stored application programs (see Shaffer et al., col. 5, lines 34-64); and start the application program associated with the obtained file type to open the received document file based upon the application program determined in the search without user input, when it is determined that the application program associated with the obtained file type is stored in the memory (see Shaffer et al., col. 5, line 65-col. 6, line 33). But fails to teach a network system, comprising: a scanner configured to scan image data; and a terminal apparatus configured to be connected to the scanner via a network, the terminal apparatus being further configured to: receive, from the scanner, a control file including a file name; receive, from the scanner, a document file, the document file including image data scanned by the scanner. However, Shih teaches a network system, comprising: a scanner configured to scan image data; and a terminal apparatus configured to be connected to the scanner via a network, the terminal apparatus being further configured to: receive, from the scanner, a control file including a file name; receive, from the scanner, a document file, the document file including image data scanned by the scanner (see Shih, col. 3, lines 10-26). It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Shaffer et al. to a network system, comprising: a scanner configured to scan image data; and a terminal

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apparatus configured to be connected to the scanner via a network, the terminal apparatus being further configured to: receive, from the scanner, a control file including a file name; receive, from the scanner, a document file, the document file including image data scanned by the scanner in order to allow a large number of functions of the scanner, such as e-mailing, to be easily inputted through the keys on a keyboard (see Shih, col. 3, lines 33-46).

11. As per claim 23, Shih teaches a terminal apparatus, the controller being further configured receive data from the scanner (see Shih, col. 3, lines 10-26) and Shaffer et al. teaches the controller being further configured to determine whether data received comprises a control file and a document file, and when the controller determines that the received data includes the control file and the document file, to search the memory (see Shaffer et al., col. 4, lines 9-56).

12. As per claim 25, Shaffer et al. and Shih teach a terminal apparatus, the controller being configured to utilize the file extensions to search the memory for the associated application program (see Shaffer et al., col. 5, lines 34-64).

13. As per claim 26, Shaffer et al. and Shih teach a terminal apparatus, the controller being configured to determine which application program to start, based upon data stored in memory, without user input (see Shaffer et al., col. 4, lines 9-56).

14. Claims 16-19 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shaffer et al. and Shih as applied to claim 15 above, and further in view of Shima (2002/0004802).

15. As per claim 16, Shaffer et al. and Shih teach the mentioned limitations of claim 15 above but fail to teach a terminal apparatus, wherein the controller receives, from the scanner, the control file and the document file, according to a Lpr/Lpd protocol.

However Shima teaches a terminal apparatus, wherein the controller receives, from the scanner, the control file and the document file, according to a Lpr/Lpd protocol (see Shima, ¶ 167). It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Shaffer et al. and Shih to a terminal apparatus, wherein the controller receives, from the scanner, the control file and the document file, according to a Lpr/Lpd protocol in order to print a file using this specific protocol (see Shima, ¶ 167).

16. As per claim 17, Shaffer et al. and Shih teach the mentioned limitations of claim 15 above but fail to teach a terminal apparatus, wherein the controller displays the image data included in the document file on a display of the terminal apparatus, in the form of thumbnail. However, Shima teaches a terminal apparatus, wherein the controller displays the image data included in the document file on a display of the terminal apparatus, in the form of thumbnail (see Shima, ¶ 169). It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Shaffer et al. and Shih to a terminal apparatus, wherein the controller displays the image data included in the document file on a display of the terminal apparatus, in the form of thumbnail in order to indicate a prediction result (prescan) before the formal image read is executed (see Shima, ¶ 130).

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17. As per claim 18, Shaffer et al. and Shih teach the mentioned limitations of claim 15 above but fail to teach a terminal apparatus, wherein the memory stores a plurality of display states associated with the information indicating the plurality of the file types, and the controller displays the image data included in the document file on a display of the terminal apparatus, based on the display state associated with the obtained file type. However, Shima teaches a terminal apparatus, wherein the memory stores a plurality of display states associated with the information indicating the plurality of the file types, and the controller displays the image data included in the document file on a display of the terminal apparatus, based on the display state associated with the obtained file type (see Shima, ¶ 130-131). It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Shaffer et al. and Shih to a terminal apparatus, wherein the memory stores a plurality of display states associated with the information indicating the plurality of the file types, and the controller displays the image data included in the document file on a display of the terminal apparatus, based on the display state associated with the obtained file type in order to give an operation instruction to another image information input-output unit (see Shima, ¶ 134).

18. As per claim 19, Shaffer et al. and Shih teach the mentioned limitations of claim 15 above but fail to teach a terminal apparatus, wherein the display state comprises displaying the image data in the form of a thumbnail. However, Shima teaches a terminal apparatus, wherein the display state comprises displaying the image data in the form of a thumbnail (see Shima, ¶ 169). It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Shaffer et al. and Shih to a

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terminal apparatus, wherein the display state comprises displaying the image data in the form of a thumbnail in order to indicate a prediction result (prescan) before the formal image read is executed (see Shima, ¶ 130).

19. As per claim 22, Shaffer et al. and Shih teach the mentioned limitations of claim 15 above but fail to teach a terminal apparatus, wherein the interface is configured to be connectable to each of a plurality of scanners via a network, and the controller is configured to receive, from one of the plurality of the scanners, a control file including a file name and to receive, from the one of the plurality of the scanners, a document file, the document file including image data scanned by the scanner. However, Shima teaches a terminal apparatus, wherein the interface is configured to be connectable to each of a plurality of scanners via a network (see Shima, ¶ 24), and the controller is configured to receive, from one of the plurality of the scanners, a control file including a file name and to receive, from the one of the plurality of the scanners, a document file, the document file including image data scanned by the scanner (see Shima, ¶ 131). It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Shaffer et al. and Shih to a terminal apparatus, wherein the interface is configured to be connectable to each of a plurality of scanners via a network, and the controller is configured to receive, from one of the plurality of the scanners, a control file including a file name and to receive, from the one of the plurality of the scanners, a document file, the document file including image data scanned by the scanner in order to allow a user who uses retrieval information to specify control information and thus

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simply entering predetermined retrieval information registered in various units for performing various types of image information processing (see Shima, ¶ 24).

20. Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shaffer et al. and Shih as applied to claim 15 above, and further in view of Tomat (6,784,925). Shaffer et al. and Shih teach the mentioned limitations of claim 15 above but fail to teach a terminal apparatus, wherein the memory stores file extensions with associated application programs and associated display states, the control file received from the scanner including a file extension. However, Tomat '925 teaches a terminal apparatus, wherein the memory stores file extensions with associated application programs and associated display states, the control file received from the scanner including a file extension (see Tomat '925, col. 16, line 62-col. 17, line 5). It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Shaffer et al. and Shih to a terminal apparatus, wherein the memory stores file extensions with associated application programs and associated display states, the control file received from the scanner including a file extension in order to integrate a digital camera as a system object into windowing applications for viewing system objects, such as Explorer or My Computer.RTM., and to provide visual feedback and drag and drop functionality with respect to all data files stored in the camera (see Tomat '925, col. 1, line 56-col. 2, line 6).

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21. Claim 35 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shaffer et al. and Shih as applied to claim 15 above, and further in view of Kumpf et al.

(6,289,371). Shaffer et al. and Shih teach the mentioned limitations of claim 15 above but fail to teach a terminal apparatus, wherein the controller closes the connection with the scanner without opening the received document file, when it is determined that the application program associated with the obtained file type is not stored in the memory. However, Kumpf et al. teaches a terminal apparatus, wherein the controller closes the connection with the scanner without opening the received document file, when it is determined that the application program associated with the obtained file type is not stored in the memory (see Kumpf et al., col. 7, lines 31-40). It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Shaffer et al. and Shih to a terminal apparatus, wherein the controller closes the connection with the scanner without opening the received document file, when it is determined that the application program associated with the obtained file type is not stored in the memory in order to create a dynamic interaction between client and server through a general purpose software program sent from the server to the client to provide improved scan control via a web browser over a network (see Kumpf et al., col. 2, lines 1-7).

22. Claims 21, and 27-34 have similar limitations as to claims 15-20, 22-26, and 35 above; therefore, they are being rejected under the same rationale.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ranodhi Serrao whose telephone number is (571)272-7967. The examiner can normally be reached on 8:00-4:30pm, M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal Dharia can be reached on (571)272-3880. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

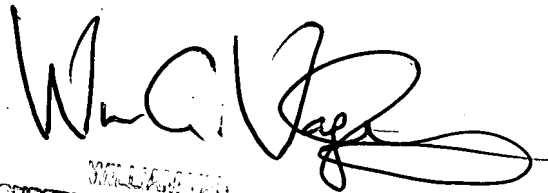
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RNS

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8/15/2007


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